

REMARKS

In the Office Action, the Examiner took the following actions:

- a) rejected claims 1, 10, 11, 14-16, 25, 26, 33, 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0018969 of Humpleman et al. ("Humpleman") in view of Las Vegas, Nevada, Hosts Infomercial Awards Conference, October 2, 2002, by Mark Albright, Knight-Ridder/Tribune Business News, pages 1-4 ("Albright");
- b) rejected claims 2-6, 18, 27, 34-38, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, and further in view of Skin Care and Acne Treatment Products from Proactiv Solution Infomercial by Guthy-Renker (2001, 2002) ("Guthy-Renker");
- c) rejected claims 7, 8, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, as applied to claim 1, and Total Gym Infomercial by Engineering Fitness International Inc. (1996-2001) ("EFI");
- d) rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman, Albright, and EFI, as applied to claim 7, and further in view of Examiner's Official Notice;
- e) rejected claims 12, 13, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, and further in view of U.S. Patent No. 6,735,572 to Landesmann ("Landesmann");
- f) rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman, Albright, and Guthy-Renker, and further in view of U.S. Patent No. 5,335,679 to Baxter ("Baxter");
- g) rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman, Albright, Guthy-Renker, and Baxter, and further in view of U.S. Patent No. 6,770,103 to Patel et al. ("Patel");
- h) rejected claims 21, 22, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, and further in view of U.S. Patent No. 6,443,840 to Von Kohorn ("Von Kohorn"); and
- i) rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, as applied to claim 1, and

Von Kohorn and further in view of U.S. Patent No. 7,006,983 to
Packes, Jr. et al. ("Packes").

By this Reply, Applicants have amended claims 1, 16, 17, 21, and 33, added new claim 44, and canceled claim 15. Some of the subject matter of canceled claim 15 has been incorporated into claim 1. Claims 1-14 and 16-44 are currently pending, with claims 1 and 33 being independent. Claims 28-32 have been withdrawn from consideration as being non-elected. Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections.

I. **§ 103(a) Rejection of Claims 1, 10, 11, 14-16, 25, 26, 33, 40, 42, and 43 Based on Humpleman and Albright**

Applicants respectfully traverse the § 103(a) rejection of claims 1, 10, 11, 14-16, 25, 26, 33, 40, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view Albright. A *prima facie* case of obviousness has not been established with respect to claims 1, 10, 11, 14-16, 25, 26, 33, 40, 42, and 43.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. "In determining the differences

between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A. Claim 1

Amended independent claim 1 recites, among other things, “during the program, encouraging the consumers to request an incentive associated with a prospective purchase of the product, the incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing the product.” The cited references fail to teach or suggest the recited subject matter.

With respect to claim 15 (now canceled and the subject matter of which has been incorporated into claim 1), the Office Action asserts that Humpleman discloses that the e-coupon of Humpleman includes a digital signature thereby suggesting that the e-coupon includes a unique code. Office Action at 5-6. However, as correctly observed by the Examiner, the digital signature is generated for e-coupon copying fraud prevention. Id. “[T]he e-coupon uses double digital signature. The first signature 208 validates the coupon and the second signature 210 validates the use of the coupon.”

Humpleman, page 6, paragraph [0097]. A coupon that can be validated for protecting against copying fraud does not correspond with “. . . a unique code for tracking usage of [an] incentive to obtain information related to marketing [a] product,” as recited in amended independent claim 1. Thus, the e-coupon of Humpleman with a digital signature does not teach or suggest “. . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in amended independent claim 1.

Albright does not cure these deficiencies of Humpleman, and the Office Action does not allege otherwise as Albright is relied upon only for its alleged teachings of “broadcasting a program of at least about 10 minutes in duration, the program containing information about the mass consumer product.” Office Action at 3.

In view of the above-noted deficiencies of the Humpleman reference, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Moreover, there is no motivation for one of ordinary skill in the art to modify the teachings of the references to achieve the claimed combination. Thus, the Office Action has failed to clearly articulate a reason why claim 1 would have been purportedly obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1.

With respect to claim 17, the Office Action alleges that Landesmann “teaches buyer-driven targeting of purchasing entities having the code which provides information for future marketing efforts for the product,” and thus “it would have been [purportedly] obvious to . . . include the code which provides information for future marketing efforts

for the product.” Office Action at 21-22. However, Landesmann teaches **tracking buyer entities via their membership ID**, which is not the same as “. . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in claim 1. Thus, Landesmann would not cure the deficiencies of Humpleman and Albright.

For at least these reasons, the cited references do not support the § 103(a) rejection of amended independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of amended independent claim 1 based on Humpleman and Albright.

B. Claims 10, 11, 14, 16, 25, and 26 and New Claim 44

Claims 10, 11, 14, 16, 25, and 26 and new claim 44 depend from amended independent claim 1. Thus, these dependent claims are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 10, 11, 14, 16, 25, and 26 based on Humpleman and Albright.

C. Claim 33

Amended independent claim 33 recites, among other things, “[a] broadcast medium, comprising . . . [a] program [that] includes encouraging consumers to request an incentive associated with a prospective purchase of [a] product, the incentive being described in the program as redeemable by the consumers during a visit to at least one of the retail establishments at the time of obtaining the product, the incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing the product.” As explained above with respect to amended

independent claim 1, Humpleman and Albright, taken alone or in combination, fail to teach or suggest “ . . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in amended independent claim 33.

For reasons at least similar to the reasons set forth with respect to amended independent claim 1, a *prima facie* case of obviousness has not been established with respect to claim 33. In addition, as explained above with respect to amended independent claim 1, Landesmann would not cure the deficiencies of Humpleman and Albright. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of amended independent claim 33 based on Humpleman and Albright.

D. Claims 40, 42, and 43

Claims 40, 42, and 43 depend from amended independent claim 33. Thus, the dependent claims are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 40, 42, and 43 based on Humpleman and Albright.

II. § 103(a) Rejection of Claims 2-6, 18, 27, 34-38, and 41 Based on Humpleman, Albright, and Guthy-Renker

Claims 2-6, 18, and 27 depend from amended independent claim 1, and claims 34-38 and 41 depend from amended independent claim 33. As explained above with respect to amended independent claims 1 and 33, Humpleman and Albright, taken alone or in combination, fail to teach or suggest “ . . . [an] incentive being associated

with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in amended independent claims 1 and 33.

Guthy-Renker fails to cure these deficiencies of Humpleman and Albright, and the Office Action does not allege otherwise as Guthy-Renker is relied upon only for its alleged teachings related to demonstrating a product during broadcasting of a program and alleged teachings that the product is at least one of a personal care product and a cosmetic product. Office Action at 8-16. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 2-16, 18, 27, 34-38, and 41. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 2-16, 18, 27, 34-38, and 41 based on Humpleman, Albright, and Guthy-Renker.

III. § 103(a) Rejection of Claims 7, 8, and 39 Based on Humpleman, Albright, and EFI

Claims 7 and 8 depend from amended independent claim 1, and claim 39 depends from amended independent claim 33. As explained above with respect to amended independent claims 1 and 33, Humpleman and Albright, taken alone or in combination, fail to teach or suggest “ . . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in amended independent claims 1 and 33.

EFI fails to cure these deficiencies of Humpleman and Albright, and the Office Action does not allege otherwise as EFI is relied upon only for its alleged teachings of having contact information for consumers to use to request an incentive. Office Action at 17-18. For at least these reasons, the cited references do not support the § 103(a)

rejection of claims 7, 8, and 39. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 7, 8, and 39 based on Humpleman, Albright, and EFI.

IV. § 103(a) Rejection of Claim 9 Based on Humpleman, Albright, EFI, and the Examiner's Official Notice

Claim 9 depends from claim 7, which depends from amended independent claim 1. As explained above with respect to claim 7, Humpleman, Albright, and EFI, taken alone or in combination, fail to teach or suggest “ . . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as indirectly recited in claim 7.

The Examiner's Official Notice, which Applicants respectfully disagree with, fails to cure these deficiencies of Humpleman, Albright, and EFI, as the Examiner's Official Notice alleges that “it is [purportedly] old and well known in the art to encourage consumers several times during a television program or infomercial of incentives.” Office Action at 19. For at least these reasons, the cited references and the Examiner's Official Notice do not support the § 103(a) rejection of claim 9. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 9 based on Humpleman, Albright, EFI, and the Examiner's Official Notice.

V. § 103(a) Rejection of Claims 12, 13, and 17 Based on Humpleman, Albright, and Landesmann

Claims 12, 13, and 17 depend from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman and Albright, taken alone or in combination, fail to teach or suggest “ . . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to

marketing [a] product,” as recited in amended independent claim 1. Also, as explained above with respect to amended independent claim 1, Landesmann would not cure the deficiencies of Humpleman and Albright. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 12, 13, and 17. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 12, 13, and 17 based on Humpleman, Albright, and Landesmann.

VI. § 103(a) Rejection of Claim 19 Based on Humpleman, Albright, Guthy-Renker and Baxter

Claim 19 depends from claim 18, which depends from amended independent claim 1. As explained above with respect to claim 18, Humpleman, Albright, and Guthy-Renker, taken alone or in combination, fail to teach or suggest “ . . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as indirectly recited in claim 18.

Baxter fails to cure these deficiencies of Humpleman, Albright, and Guthy-Renker, and the Office Action does not allege otherwise as Baxter is relied upon only for its alleged teachings of “a device and process for use in coloring hair having a hair coloring kit for performing a multi-step hair coloring process.” Office Action at 22. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 19 based on Humpleman, Albright, Guthy-Renker, and Baxter.

VII. § 103(a) Rejection of Claim 20 Based on Humpleman, Albright, Guthy-Renker, Baxter, and Patel

Claim 20 depends from dependent claim 19. As explained above with respect to claim 19, Humpleman, Albright, Guthy-Renker, and Baxter, taken alone or in combination, fail to teach or suggest “. . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as indirectly recited in claim 19.

Patel fails to cure these deficiencies of Humpleman, Albright, Guthy-Renker, and Baxter, and the Office Action does not allege otherwise as Patel is relied upon only for its alleged teachings of “a method and composition for the gradual permanent coloring of hair compris[ing] a hair coloring kit for performing a multi-step hair coloring process[,] the multi-step hair coloring process compris[ing] applying highlighting material to moist hair and the demonstrating includ[ing] demonstrating the applying of the highlight material to moist hair.” Office Action at 23. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 20. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 20 based on Humpleman, Albright, Guthy-Renker, Baxter, and Patel.

VIII. § 103(a) Rejection of Claims 21, 22, and 24 Based on Humpleman, Albright, and Von Kohorn

Claims 21, 22, and 24 depend from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman and Albright, taken alone or in combination, fail to teach or suggest “. . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in amended independent claim 1.

Von Kohorn fails to cure these deficiencies of Humpleman and Albright, and the Office Action does not allege otherwise as Von Kohorn is relied upon only for its alleged teachings of “evaluation of responses of participatory broadcast audience with prediction of winning contestants; monitoring, checking and controlling of wagering, and automatic crediting and couponing.” Office Action at 24-26. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 21, 22, and 24. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 21, 22, and 24 based on Humpleman, Albright, and Von Kohorn.

IX. § 103(a) Rejection of Claim 23 Based on Humpleman, Albright, Von Kohorn, and Packes

Claim 23 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman and Albright, taken alone or in combination, fail to teach or suggest “. . . [an] incentive being associated with a unique code for tracking usage of the incentive to obtain information related to marketing [a] product,” as recited in amended independent claim 1.

As explained above with respect to claims 21, 22, and 24, Von Kohorn fails to cure the deficiencies of Humpleman and Albright. Packes fails to cure the deficiencies of Humpleman, Albright, and Von Kohorn, and the Office Action does not allege otherwise as Packes is relied upon only for its alleged teachings of “a method and system for processing a mail-in-rebate certificate.” Office Action at 27. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 23.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the
§ 103(a) rejection of claim 23 based on Humpleman, Albright, Von Kohorn, and Packes.

X. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


The preceding arguments are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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